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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,174	02/02/2001	B. J. Hawkins	2073.300	2201
167 7590 09/05/2008 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071				
EXAMINER NGUYEN, TAN D				
ART UNIT 3689		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/776,174

**Applicant(s)**

HAWKINS, B. J.

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,7-9,11 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-9,11 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed of 2/25/08 has been entered. Claims 1-3, 7-9, 11, and 16-19 are pending and rejected as followed. There is 1 independent method claim set.

### ***Claim Status***

Claims 1-3, 7-9, 11, and 16-19 (method) are pending.

As of 2/25/08, independent method claim 1 is as followed:

1. (Currently Amended) A computerized process for requisitioning products and services in an organization comprising the steps of:

(a) providing an originator with an electronic requisition form for documenting a requisition process involving one or more products or services to be purchased in a subsequent negotiated bidding process and for designating one or more reviewers to review and comment on said requisition process one or more approvers to review and approve said requisition form;

b) automatically submitting said the completed electronic requisition form over a computer network simultaneously to all said designated reviewers for review and comment during a set review period so that if any reviewer fails to review and submit comments within the review period said reviewer is deemed to have abstained from submitting any comments to said requisition form;

c) as soon as comments have been submitted by all said designated reviewers or as soon as said review period has terminated, automatically submitting the requisition form and any comments submitted by the reviewers to said designated approvers in a designated sequence for review and approval;

d) automatically submitting the approved requisition form for a negotiated bidding process upon receipt of approval from all of said approvers;

e) informing the originator with the status of the requisition process and with any comments submitted by the designated reviewers and approvers, and

(f) providing the originator with an opportunity to withdraw the requisition form at any time prior to the completion of the requisition.

Note: for convenience, letters (a)-(f) are added to the beginning of each step.

Also, in step (a), the phrase "for documenting ....and approve said requisition form" is not a positively recited method step but, rather, is mere intended use of the form and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

Similarly, in step (b), the phrase "for review and comment ....said requisition form" is not a positively recited method step but, rather, is mere intended use of the reviewers and thus having no patentable weight.

Similarly, in step (f), the phrase "to withdraw ....completion of the requisition" is not a positively recited method step but, rather, is mere intended use of "an opportunity" and thus having no patentable weight.

### ***Claim Objections***

1. Claims 2-3, 7-9, 11, 16, 18-19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

1) Claim 2 deals with providing the originator with a copy of the withdrawn requisition form for possible revision and resubmission. The term "the withdrawn requisition form" lacks antecedent basis since there is no positively recited step of "withdrawing the submitted requisition form" earlier or before. As indicated in the note in step (f) above, the phrase "to withdraw ....completion of the requisition" is not a positively recited method step but, rather, is mere intended use of "an opportunity". Dependent claims 3 and 7-9, 11, 16, 18-19 depend on claim 2 so they are objected as well.

2) Furthermore, it's not clear how dep. claim 3 with the "draft requisition form" further limits the steps and elements of claim 1 above.

***Claim Rejections - 35 USC § 112***

2. Claims 1-3, 7-9, 11, 16 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 1, step (b) recites the limitation "the completed electronic requisition form" in the first line. There is insufficient antecedent basis for this limitation in the claim.

2) Claim 2, line 2, recites the limitation "the withdrawn requisition form". There is insufficient antecedent basis for this limitation in the claim.

3) Claim 3, line 2, recites the limitation "the preparation of a draft requisition form". There is insufficient antecedent basis for this limitation in the claim.

1.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over PETERSON ET AL and PLANALP ET AL.

As for claim 1, PETERSON ET AL fairly discloses a computerized process for requisitioning products and services in an organization comprising the steps of:

(a) providing an originator (user or requester) with an electronic requisition form

{see col. 5, lines 5-15, col. 30, lines 50-67, col. 31, lines 5-37, Fig. 20, element 692 "REQ'N FORM" or element 698 "DISPLAY REQ'N FORM",

b) automatically submitting said the completed electronic requisition form over a computer network simultaneously to all said designated reviewers;

{see col. 5, lines 5-15, col. 30, lines 50-67, col. 31, lines 5-37}

c) automatically submitting the requisition form and any comments submitted by the reviewers to said designated approvers in a designated sequence for review and approval;

{see col. 30, lines 50-67, col. 31, lines 5-37}

d) automatically submitting the approved requisition form for a negotiated bidding process upon receipt of approval from all of said approvers;

{Fig. 14, Fig. 15, 376, col. 40, lines 20-40}

e) informing the originator with the status of the requisition process and with any comments submitted by the designated reviewers and approvers, and

{see Figs. 14, elements 600, "GET ORDER STATUS", 704, 706, Figs 18-20}

(f) providing the originator with an opportunity to withdraw the requisition form at any time prior to the completion of the requisition.

{see Fig. 14, element 707, Fig. 15, 374 "CANCEL ORDER", Figs. 18-20}

PETERSON ET AL fairly teaches the claimed invention except for carrying out step (c) as a function of as soon as comments have been submitted by all said designated reviewers or as soon as said review period has terminated.

In a similar computerized process for managing approval of a request for a service or product, PLANALP ET AL discloses an electronic review and approval of data or by enabling approval of request or data at various stages of completion and provides approval conditions on prior and/or subsequent approvals and with the attached comments or suggestion from the reviewers or approvers {see Figs. 10, 11, 25 "Comments", cols. 2-3}. PLANALP ET AL also discloses a set of review/approve period

such as "Effective Date", "Expiration Date" or Deadline for certain tasks to effectively manage/monitor the project to meet the time frame or as scheduled, see Figs. 10 or 13. PLANALP ET AL also discloses the approved standards such as the parties involved, "Originator", "Peer Reviewer", "Approver", "Business Team", etc., and the dates parameters indicated above. Therefore, it would have been obvious to modify step ( c) of PETERSON ET AL by using the approved standards such as selected "peer reviewer" or "deadline" such as "effective date" or "expiration date" or "approval date" as taught by PLANALP ET AL to effectively manage/monitor the project as scheduled or meeting the time frame.

Note also that the combination of PETERSON ET AL /PLANALP ET AL also discloses most of the features in the dep. claims of 2-3, 7-9, 11 and 16-19. For example, the teaching of dep. claim 2 is cited on Figs. 14, 15 and col. 31 of PETERSON ET AL , claim 3 on PLANALP ET AL col. 3, lines 10-25, claim 7 on Fig. 6 of PETERSON ET AL, etc. Claims 8-9 and 11 are taught in PETERSON ET AL Figs. 14-15, 20 and PLANALP ET AL Figs. 10 and 13. Claims 16 and 18-19 are fairly taught in PLANALP ET AL Figs. 10-13.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689